UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,143	01/21/2000	William J. Baer	STL000020US1	5414

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EXAMINER
SMITH, PETER J

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td colspan="2">Application No.</td><td colspan="2">Applicant(s)</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2004*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-27* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed on 4/23//2004.

2.   Claims 1-27 are pending in the case. Claims 1, 9, and 17 are independent claims.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   **Claims 1-2, 9-10, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated**

by Dedrick, US 5,768,521 patented 6/16/1998.

      Regarding independent claims 1, 9, and 17, Dedrick discloses determining a content

count for a content object and determining from the content object count a price for the content

object in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25.

      Regarding dependent claims 2, 10, and 18, Dedrick discloses determining a content

count for each content entity, and summing the entity content counts to obtain a content count for

the content object in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claims 3-6, 11-14, 19-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, US 5,768,521 patented 6/16/1998.**

Regarding dependent claims 3, 11, and 19, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dedrick to have used a character for the content entity.

Regarding dependent claims 4, 12, and 20, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content

entity will increase the representative byte count by the same unit amount that a character count would increase.

Determining a page count from the character count is merely changing the units of the count from characters to pages. Dedrick teaches a information unit count of bytes in col. 4 lines 63-64 and megabytes in col. 5 lines 21-23. The two example units of Dedrick are related exactly as the characters and pages of the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dedrick to have converted characters into pages so that the cost computation could have been simplified.

Regarding dependent claims 5, 13, and 21, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25. Dedrick teaches specific examples that the content count unit may be in bytes or words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a character count. However, Dedrick's teaching of a byte unit count will correlate exactly in proportion to the size of the content entity just as a character count will correlate exactly in proportion to the size of the content entity. Each additional character contained in the content entity will increase the representative byte count by the same unit amount that a character count would increase. Dedrick teaches counting the number of bytes in a content entity, determining the content entity type, and determining an average character count for content entities of that type in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25.

Regarding dependent claims 6, 14, and 22, Dedrick teaches determining a unit of information count for the content entity in col. 1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25. Dedrick teaches specific examples that the content count unit may be in bytes or

words in col. 4 lines 63-64. Dedrick does not specifically teach that the unit of information is a

page count. However, Dedrick's teaching of a byte unit count will correlate exactly in

proportion to the size of the content entity just as a page count will correlate exactly in

proportion to the size of the content entity. Each additional page contained in the content entity

will increase the representative byte count by the same unit amount that a page count would

increase. Dedrick teaches multiplying the page count with a predetermined price per page in col.

1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25.

Regarding dependent claims 25, 26, and 27, Dedrick teaches wherein the content

object comprises electronic text, audio, video, graphics, animation or other electronic

information in col. 4 lines 26-51. An electronic book is a composition of electronic information

as is described by Dedrick. Dedrick teaches wherein the electronic information content entity is

interactively created by the end user in col. 4 lines 39-51. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have modified Dedrick to have

enabled an end user to have interactively created an electronic book by selecting from a plurality

of electronic information content entities so that the user could have had a customized electronic

book.

7.   **Claims 7-8, 15-16, and 23-24 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Dedrick, US 5,768,521 patented 6/16/1998 in view of Khan et al.

(hereinafter "Khan"), US 6,199,054 B1 filed 3/5/1998.

Regarding dependent claims 7, 15, and 23, Dedrick teaches wherein a user may

interactively select from a plurality of content entities to form a customized content object in col.

1 line 62 – col. 2 line 22, and col. col. 4 line 26 – col. 5 line 25. Dedrick teaches variable content

entity pricing in col. 5 lines 23-25. Dedrick does not teach that at least one of the content entities

comprises user provided content. Khan does teach wherein a user may selectively add a user-

provided content entity subject to price metering in col. 3 lines 61-64. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to have combined

the user-provided content teaching of Khan into Dedrick to have created the claimed invention.

It would have been obvious and desirable to have allowed the user to have provided content to

further customize the interactive selection of content entities composing the content object.

   Regarding dependent claims 8, 16, and 24, Dedrick teaches wherein the price for user-

provided material is determined in a first manner if the content count exceeds a predetermined

content count maximum, and is determined in a second manner if the content count does not

exceed the predefined maximum in col. 5 lines 23-25.

                                   Response to Arguments

8.   Applicant's arguments with respect to claims 1-27 have been considered but are moot in

view of the new ground(s) of rejection. Dedrick discloses a metering mechanism which can

meter the flow of electronic information to a user. The electronic information may be text,

audio, video, graphics, or other digital information and may be provided to the user in portions if

desired. The pricing of the content may be variable. Khan et al. discloses a system which

monitors a digital payload provided by a user and levies a metered charge to the user for

transmitting the user provided data. The Examiner believes a combination of these two

references by one of ordinary skill in the art at the time of the invention renders the claimed

invention obvious.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Subler et al., US 5,646,992 patented 7/8/1997 discloses assembly, distribution, and

use of digital information. Holmes et al., US 6,119,108 filed 10/1/1998 discloses a secure

electronic publishing system. Dedrick, US 5,717,923 patented 2/10/1998 discloses dynamically

customizing electronic information to individual end users. Hartrick et al., US 5,532,920

patented 7/2/1996 discloses enforcing payment of royalties when copying softcopy books.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peter J Smith whose telephone number is 703-305-5931 (571-

272-4101 after 10/20/2004). The examiner can normally be reached on Mondays-Fridays

7:00am-3:30pm.

       If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on 703-305-9792 (571-272-4090 after 10/20/2004).

The fax phone number for the organization where this application or proceeding is assigned is

703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS

September 15, 2004

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER